UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/765,246	01/18/2001	Jonathan Lowthert	BKA.0008US	8160

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>19 November 2007</u>.
2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-28 and 30-37</u> is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>1-28 and 30-37</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All b)☐ Some * c)☐ None of:
        1.☐ Certified copies of the priority documents have been received.
        2.☐ Certified copies of the priority documents have been received in Application No. _____.
        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.
4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

Appeal Brief

In view of the appeal brief filed on November 19th, 2007, PROSECUTION IS

HEREBY REOPENED. New rejections are set forth below.

To avoid abandonment of the application, appellant must exercise one of the

following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply

under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed

by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and

appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth

in 37 CFR 41.20 have been increased since they were previously paid, then appellant

must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by

signing below:

/Chris Kelley/

Supervisory Patent Examiner, Art Unit 2424.

Response to Arguments

9. Applicant's arguments filed November 20th, 2007 have been fully considered but

they are not persuasive.

Applicant argues (see Brief, page 13) that, "there is no choosing on the receiver

an advertisement resource from the first set". Examiner respectfully disagrees. Pico

discloses a method where a receiver selectively filters incoming ad content based on

ad characteristics matching the user characteristics. See column 6 lines 25-31.

Therefore the first subset of advertisements is the ads transmitted to a plurality of

users based on statistical data gathered about the plurality of users viewing patterns.

When the receiver compares a received ad with user characteristics stored in the

user's receiver, the resulting match generated is the second subset of ad. When a

match is generated the user stores the advertisement that matches user's

characteristics.

Applicant's arguments (see Brief page 13-14) with respect to claims 3 and 33 are

rendered moot in view of new grounds of rejection.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form

the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless —
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1, and 7-9, are rejected under 35 U.S.C. 102(e) as being anticipated by

Picco et al. (US Pat. 6,029,045).

With regards to claim 1, Picco discloses a system for allowing the use of

content (see column 4, lines 51-54) on a content receiver ;

Collecting information about one or more characteristics of the receiver (see

column 7, lines 15-23);

Providing the collected information to a remote processor based system (data

provided to agent 150, see column 7, lines 23-24);

The agent 150 determines based on collected statistical data, determines a

first subset of local content to a distribution audience. See column 7, lines 28-31.

The local content further comprises content profiles or "guidelines" for distributing

the advertising materials on the receiver. See column 6, lines 62-67. Picco

accordingly meets the limitation of the receiver receiving, from the remote processor-

based system, a first subset listing of advertising resources and guidelines for

distributing advertising materials on the receiver, the first subset listing of advertising

resources selected from a database of advertising resources (col. 6 lines 57-61)

based on at least one of the one or more characteristics of the receiver (i.e. usage

data).

Picco discloses that not all the households receiving the first subset of

advertising resources and guidelines actually store the content. Rather only a

predetermined portion of the received pieces (i.e. a second subset) maybe stored by

the set top box after comparing content profile of the received pieces with user

preferences (see column 4 lines 1-4, col. 6 lines 25-34). Therefore Picco teaches

the step of automatically and selectively choosing (by matching/filtering) on the

receiver without user intervention an advertising resource from the firs subset listing

based on a given characteristic (user preferences) of the receiver to compile a

second subset (i.e. when a match is found at step 234, fig. 9) of advertising

resources, the second subset of listing finer tuned to a characteristic of the receiver

than the first subset listing; and

Capturing (downloading) an advertisement listed on the second subset listing

of advertising resources to store the advertisement on the content receiver (see

column 7, lines 56-61).

With regards to claim 7, the system comprises a method as stated above in

Claim 1, wherein the advertising has associated an associated content profile, which

is compared to the user's profile for storage and playback (see Picco: Col. 7, Line 55

- Col. 8, Line 22). This reads on the claimed determining a characteristic of

advertising and comparing it to information about the use of the receiver.

With regards to Claim 8, Picco discloses a method as stated above in Claim

1, wherein a user is operable to select television signals from satellite broadcasting

for watching (Col. 5, Lines 10-16). The watching of satellite television signal reads

on the claimed enabling a variety of content to be selected for play at any time.

With regard to claims 9, the system discloses inserting (splicing) advertising

data into program while a program is displayed. See column 14, lines 4-13. By

inserting the advertisement while the program is still playing, the advertisement is

inserted after allowing the content to be used for a predetermined about of time.

Accordingly the playback of the programming content is replaced with the playback

of the advertisement.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

13. Claims 2 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Picco et al. (US Pat. 6,029,045).

With regards to claim 2, the modified system comprises a method as stated

above in Claim 1, wherein the set top box is operable to update content (see Picco:

Col. 7, Lines 35-41) by storing selected local content as stated above, including

overwriting or removing selected content (see Picco: Col. 10, Line 62- Col. 11, Line

1). This reads on the claimed combining the advertising listing with subset with

advertising available on the receiver Examiner further takes Official notice that

updating content can include the step of adding data thereby expanding the local

database. It would have been obvious to one of ordinary skill in the art to further

modify the system by combining the subset listing of advertising resources with

advertising resources available on the receiver in order to expand the database at

the local receiver. The modified system additionally comprises the method of

automatically and selectively choosing advertisement resources previously available

on the receiver to create the second subset listing. See column 10, lines 13-18.

With regards to claim 10, the system is silent on the step of controlling the

number of times a user may access content other than advertising that is stored on the receiver. Examiner takes official notice that it was well known in the art at the time of the invention to subsidize the cost of a program by displaying advertisement to the viewer every time a user accesses the content. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system by subsidizing the cost of a content by displaying advertising every time a content is accessed, thereby providing the user content usage for a lower cost in return for displaying targeted advertising related to the content and the user.

14. Claims 3-6, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Picco et al. (US Pat. 6,029,045) in view of Thomas et al. (US PG Pub. 2005/0149964).

   With regard to claim 3, Picco discloses that the set top box permits the user to browse the world wide web while viewing a television program. See column 13, lines 23-26. The set top box additionally determines if a web browser has been activated. See column 14, lines 22-25. While Picco discloses collecting statistics from the user, Picco is silent on the step of monitoring web-sites that user has visited and application software that the user has utilized. In an analogous art, Thomas discloses collecting information about user's usage of other non-program guide applications. See [0058]. Examiner further takes Official notice that it was well known in the art at the time of the invention to monitor a user's internet usage (e.g. Cookies), including web-sites user visits. One of ordinary skill in the art would

recognize that such information collection would be useful in gathering additional information regarding the user and subsequently aiding in better targeting content to the user. Therefore, it would have been obvious to one of ordinary skill in the art to further modify the system by additionally collecting information about a characteristic of at least one of software that is present on the receiver and monitoring websites that the user has visited in order to better target ads according to viewer's usage patterns.

With regards to claim 4, the modified system comprises a method as stated above in claim 3, wherein collecting information includes accumulating the collected data (see Picco, column 11, lines 9-13). This accumulation of the user reads on the claimed developing a database of information about activities undertaken by the user of the receiver.

With regards to claim 5, the modified system comprises the step of receiving the first subset of advertising resources from a database of advertising resources located on the remote processor based system based on information about the user of the receiver (see column 6, lines 57-61, and column 7, lines 6-23).

With regards to claims 6, Picco further comprises the step of compiling the second subset based on patterns of a user at the receiver. See column 10, lines 5-10.

With regard to claim 33, the modified system is silent on the step of collecting information about a characteristic of one of hardware and software that is present on the receiver.

In an analogous art, Thomas discloses collecting information about user's usage of other non-program guide applications. See [0058]. One of ordinary skill in the art would recognize that such information collection would be useful in gathering additional information regarding the user and subsequently aiding in better targeting content to the user. Therefore, it would have been obvious to one of ordinary skill in the art to modify the system in view of Thomas' teachings by additionally collecting information about a characteristic of at least one of software that is present on the receiver.

15. Claims 11-28, 30-32, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Picco et al. in view of Thomas et al. (US Pat. 2003/0037068).

With regards to claims 11 and 21, Picco discloses a system for allowing the use of content (see column 4, lines 51-54) on a content receiver ;

Collecting information about one or more characteristics of the receiver (see column 7, lines 15-23);

Providing the collected information to a remote processor based system (data provided to agent 150, see column 7, lines 23-24);

The agent 150 determines based on collected statistical data, determines a first subset of local content to a distribution audience. See column 7, lines 28-31. The local content further comprises content profiles or "guidelines" for distributing the advertising materials on the receiver. See column 6, lines 62-67. Picco accordingly meets the limitation of the receiver receiving, from the remote processor-

based system, a first subset listing of advertising resources and guidelines for

distributing advertising materials on the receiver, the first subset listing of advertising

resources selected from a database of advertising resources (col. 6 lines 57-61)

based on at least one of the one or more characteristics of the receiver (i.e. usage

data).

Picco discloses that not all the households receiving the first subset of

advertising resources and guidelines actually store the content. Rather only a

predetermined portion of the received pieces (i.e. a second subset) maybe stored by

the set top box after comparing content profile of the received pieces with user

preferences (see column 4 lines 1-4, col. 6 lines 25-34). Therefore Picco teaches

the step of automatically and selectively choosing (by matching/filtering) on the

receiver without user intervention an advertising resource from the firs subset listing

based on a given characteristic (user preferences) of the receiver to compile a

second subset (i.e. when a match is found at step 234, fig. 9) of advertising

resources, the second subset of listing finer tuned to a characteristic of the receiver

than the first subset listing; and

Capturing (downloading) an advertisement listed on the second subset listing

of advertising resources to store the advertisement on the content receiver (see

column 7, lines 56-61).

Picco is silent on that, in response to detecting a pause in content usage,

automatically interrupt the use of content the place in the content where the pause

occurs, if the pause occurs at all, not predetermined; and while the content is

paused, enable the receiver to temporarily replace the content with advertising.

In a related art, Thomas discloses detecting pause in content usage, responsive to which interrupting the content temporarily to replace with an advertisement, wherein, the place in the content where the pause occurs, if the pause occurs at all is not determined by a content provider (i.e. use initiated pause). See Thomas: [0011].

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Picco in view of Thomas' teachings by replacing the content with a previously stored advertisement when a pause is detected to present the advertisement to the user. The motivation is to present useful information such as targeted advertisements that are in conformance with viewer's preferences over the duration of user initiated pause.

With further regards to claim 21, it is inherent that such a computer-based terminal must run programming in order to function. This reads on the claimed shell.

With regards to claims 12 and 25, Picco discloses a method where a user is operable to select television signals from satellite broadcasting for watching (see column 5, lines 10-16). The watching of satellite reads on the claimed enabling a variety of content to be selected for play at any time.

With regards to claims 13 and 26, Picco discloses a method wherein collecting information includes monitoring activities of the user of the receiver (column 11, lines 9-13).

With regards to claims 14 and 27, Picco discloses a method wherein

collecting information includes accumulating the collected data (see column 11, lines 9-13). This accumulation of the user data read on the claimed developing a database information about activities undertaken by the user of the receiver.

With regards to claim 15, Picco discloses a method, wherein advertisements are stored in a remote database and a subset of these ads are broadcast to user terminals for selective storage based on user profile information as stated above. This reads on the claimed selecting advertisements stored on the remote processor-based system (ads from the head-end's database) based on information about the user of the receiver (user profile).

With regards to claim 16 and 30, the advertisement resources are broadcast for storage at the receiver as stated above. The user's terminal must catalog the data it has stored in order to manage and retrieve data (see column 10, lines 62-67). This reads on the claimed local electronic program guide (catalog of files) compiled.

With further regards to claim 30, the advertisement resources are broadcast for storage at the receiver as stated above. The user's terminal must catalog the data it has stored in order to manage and retrieve data (see column 10, lines 62-67). This reads on the claimed local electronic program guide (catalog of files) compiled without user intervention to the second subset of advertising resources captured from the remote processor. The second subset of advertising resources is based on activity of the user that is finer tuned that the first subset listing as discussed above.

With regards to claim 17, the system comprises a method as stated above in Claim 1, wherein the advertising has associated an associated content profile, which

is compared to the user's profile for storage and playback (see Picco: Col. 7, Line 55

- Col. 8, Line 22). This reads on the claimed determining a characteristic of

advertising and comparing it to information about the use of the receiver.

With regards to Claims 18, 19, 23 and 24, Picco discloses, wherein content

has n expiration date (Co1.6, Lines 61-67) and a maximum number of times it may

be viewed (Col. 7, Lines 1-2). Further, the terminal may remove or overwrite content

(Col. 10, Line 62 - Col. 11, Line 1). This reads on the claimed automatically replacing

(overwriting) the content with advertising after allowing content to be used for a

predetermined amount of time (date or number of views). This further reads on the

claimed automatic determination at predetermined times whether to replace the

content.

Regarding Claim 20, Picco discloses an article as stated above in Claim 11,

further storing instructions that enable to receiver to catalog the advertisements it

has stored as stated above. This reads on the claimed automatically compiling a

receiver- based database of advertising. Additionally, only advertisements matching

the receiver characteristics are downloaded, and therefore the database includes a

subset of selections from the subset listing.

Regarding Claim 22, Picco discloses a method as stated above in Claim 21,

wherein the system is a television receiver (Co1. 5, Lines 12-16)

Regarding claims 28 and 31, Pico discloses wherein the storage stores

instructions that enable the receiver to access a database of available

advertisements on a specialized remote processor based system (see column 6,

lines 57-61).

Regarding Claim 32, Pico is silent on that the database of available advertisements are specialized for a language other than the national language spoken in the location of the receiver. Examiner takes official notice that it was well known in the art for local headends to support content programming in a language other than that national language because it is widely spoken in that region. As such it would have been obvious to modify the system to have database specialized with advertisements in languages other than the national language spoken in the location of the receiver in order to target ads to speakers of the other languages.

With regard to claim 34, Picco is silent on the step of detecting a user-initiated pause in content usage and in response to detecting a pause in content usage, automatically interrupting the use of the content to temporarily replace the content with a previously stored advertisement, the place in the content where the pause occurs, if the pause occurs at all is not determined by the content provider.

Thomas discloses detecting pause in content usage, responsive to which interrupting the content temporarily to replace with an advertisement, wherein, the place in the content where the pause occurs, if the pause occurs at all is not determined by a content provider (i.e. use initiated pause). See Thomas: [0011].

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Picco in view of Thomas' teachings by replacing the content with a previously stored advertisement when a pause is detected to present the advertisement to the user. The motivation is to present useful

information such as targeted advertisements that are in conformance in accordance

with viewer's preferences as well as based on receiver capabilities over the duration

of the pause.

Conclusion

16. Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Usha Raman whose telephone number is (571) 272-

7380. The examiner can normally be reached on Mon-Fri: 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the

examiner's supervisor, Christopher Kelley can be reached on (571) 272-7331. The

fax phone number for the organization where this application or proceeding is

assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

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automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-

272-1000.

/Chris Kelley/
Supervisory Patent Examiner, Art
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/Usha Raman/